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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,067	03/10/2004	Thomas M. Demartini	111325-370200	2653
22204	7590	10/17/2008		
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			EXAMINER KAMAL, SHAHID	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 10/17/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/796,067

**Applicant(s)**

DEMARTINI ET AL.

**Examiner**

SHAHID KAMAL

**Art Unit**

3621

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-11, 13-23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-11, 13-23, 25-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/06)  
Paper No(s)/Mail Date 12/13/2004, 02/19/2008, 06/30/2008
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_



## **DETAILED ACTION**

### ***Acknowledgements***

1. Claims 1, 3-11, 13-23 and 25-33 are remain pending and have been examined.
2. This Office Action is responsive to the amendment filed on June 13, 2008.

### ***Information Disclosure Statement***

3. The Information Disclosure Statement filed on 13 December 2004, 19 February 2008 and 30 June 2008 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3-11, 13-23 and 25-33 are rejected under 35 U.S.C. 102(e) as anticipated by Gilliam et al. (US Patent No. 7,206,765 B2) (“Gilliam”).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C.

102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37

CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Referring to claim 1, Gilliam discloses a method for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression, said method comprising:

a) specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable [see at least column 7, lines 11-23, column 8, lines 1-9, column 23, lines 34-47, column 26, lines 2-15 (the file and at least one response with private keying material that it can access)];

b) generating a **template** of said rights expression information, including removing said value for said variable from said element [see at least column 9, lines 6-22, col. 11, lines 6-11 – the rights can be in the form of a profile; col. 7, lines 39-55 – each time the usage rights is exercised, the value of the state variable can be incremented, which is interpreted as removing the value];

c) generating an identification for said **template** [see fig. 1& fig. 3 with associated text]; and

d) **transmitting said identification for said template to a device adapted to situationally determine said variable and enforce said rights expression information based on said variable and said identification for said template**, whereby said rights expression information can be enforced on a device based on said variable and said identification for said **template** [see abstract & claim 1].

Referring to claim 3, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said **template** in a predetermined order and situationally determining untransmitted variables [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights].

Referring to claim 4, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said **template** in a non-predetermined order and situationally determining untransmitted variables [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights].

Referring to claim 5, Gilliam discloses **a method for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression, said method comprising:**

- a) **specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable** [see at least column 7, lines 11-23, column 8, lines 1-9, column 23, lines 34-47, column 26, lines 2-15 (the file and at least one response with private keying material that it can access)];
- b) **generating a template of said rights expression information, including removing said value for said variable from said element** [see at least column 9, lines 6-22, col. 11, lines 6-11

– the rights can be in the form of a profile; col. 7, lines 39-55 – each time the usage rights is exercised, the value of the state variable can be incremented, which is interpreted as removing the value];

c) **generating an identification for said template** [see fig. 1& fig. 3 with associated text];

d) transmitting said identification for said **template** along with machine- interpretable reconstruction instructions to a device, **wherein said device is** adapted to follow said machine- interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said **template** [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights];

e) **whereby said rights expression information can be enforced on a device based on said variable and said identification for said template** [see abstract & claim 1].

Referring to claim 6, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said **template** in a predetermined order and determining untransmitted variables according to said machine- interpretable reconstruction instructions [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights].

Referring to claim 7, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said **template** in a non- predetermined order and determining the untransmitted variables according to said machine-

interpretable reconstruction instructions [see at least column 9, lines 16-45 – the user makes a request from the vendor is receives the ticket item, which includes rights].

Referring to claim 8, Gilliam further discloses transmitting said identification for said **template** to a device adapted to follow machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said **template** [see at least column 9, lines 16-45 – the user makes a request from the vendor is receives the ticket item, which includes rights].

Referring to claim 9, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said **template** in a predetermined order, determining the machine-interpretable reconstruction instructions associated with said **template**, and determining untransmitted variables according to said machine-interpretable reconstruction instructions [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights].

Referring to claim 10, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said **template** in a non-predetermined order, determining the machine-interpretable reconstruction instructions associated with said **template**, and determining the untransmitted variables according to said machine-interpretable reconstruction instructions see at least column 9, lines 16-45 – the user makes a request from the vendor is receives the ticket item, which includes rights ].

Referring to claims 11, 13-22 are rejected on the same rationale as claims 1-10 above.

Referring to claims 23, 25-33 are rejected on the same rationale as claims 1-10 above.

***Examiner's Note:***

6. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

7. Although Applicant(s) use “means for” in the claim(s) (e.g. claims 11, 13-33), it is the Examiner’s position that the “means for” phrase(s) do not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. If Applicant(s) concur, the Examiner respectfully requests Applicant(s) to either amend the claim(s) to remove all instances of “means for” from the claim(s), or to explicitly state on the record why 35 U.S.C. 112 6<sup>th</sup> paragraph should not be invoked.

Alternatively, if Applicant(s) desire to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph, the Examiner respectfully requests Applicant(s) to expressly state their desire on the record. Upon receiving such express invocation of 35 U.S.C. 112 6<sup>th</sup> paragraph, the “means for” phrase(s) will be

interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>*.<sup>1</sup>

Failure by Applicant(s) in their next response to also address the 35 U.S.C. 112 6<sup>th</sup> paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant(s) NOT to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6<sup>th</sup> paragraph applies to all examined claims currently pending.

#### ***Response to Arguments***

8. Applicant's arguments filed on June 13, 2008 have been fully considered but they are not persuasive.

As per claim 1, Applicant argues "Gilliam does not disclose specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable; generating a **template** of said rights expression information, including removing said value for said variable from said element; generating an identification for said **template**; and **transmitting said identification for said template to a device adapted to situationally determine said variable and enforce said rights expression information based on said variable and said identification for said template**, whereby said rights expression information can be enforced on a device based on said variable and said identification for said **template**" (response pages 13-20). Gilliam teaches specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a

variable and corresponding value for said variable [see at least column 7, lines 11-23, column 8, lines 1-9, column 23, lines 34-47, column 26, lines 2-15 (the file and at least one response with private keying material that it can access)]; generating a **template** of said rights expression information, including removing said value for said variable from said element [see at least column 9, lines 6-22, col. 11, lines 6-11 – the rights can be in the form of a profile; col. 7, lines 39-55 – each time the usage rights is exercised, the value of the state variable can be incremented, which is interpreted as removing the value]; generating an identification for said **template** [see fig. 1& fig. 3 with associated text]; and **transmitting said identification for said template to a device adapted to situationally determine said variable and enforce said rights expression information based on said variable and said identification for said template**, whereby said rights expression information can be enforced on a device based on said variable and said identification for said **template** [see abstract & claim 1].

As per claims 3-5, Further applicant also argues “Gilliam does not disclose transmitting one or more variables associated with said identification for said **template** in a predetermined order and situationally determining untransmitted variables; **specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable; generating a template of said rights expression information, including removing said value for said variable from said element; generating an identification for said template; transmitting said identification for said template along with machine-interpretable reconstruction instructions to a device, wherein said device is adapted to follow**

said machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said **template**; **whereby said rights expression information can be enforced on a device based on said variable and said identification for said template**" (response pages 21-22). Gilliam teaches transmitting one or more variables associated with said identification for said **template** in a predetermined order and situationally determining untransmitted variables [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights]; **specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable** [see at least column 7, lines 11-23, column 8, lines 1-9, column 23, lines 34-47, column 26, lines 2-15 (the file and at least one response with private keying material that it can access)]; **generating a template of said rights expression information, including removing said value for said variable from said element** [see at least column 9, lines 6-22, col. 11, lines 6-11 – the rights can be in the form of a profile; col. 7, lines 39-55 – each time the usage rights is exercised, the value of the state variable can be incremented, which is interpreted as removing the value]; **generating an identification for said template** [see fig. 1& fig. 3 with associated text]; transmitting said identification for said **template** along with machine- interpretable reconstruction instructions to a device, **wherein said device is** adapted to follow said machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said **template** [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights]; **whereby said rights**

**expression information can be enforced on a device based on said variable and said identification for said template** [see abstract & claim 1].

*Conclusion*

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahid Kamal whose telephone number is (571) 270-3272. The examiner can normally be reached on MONDAY through THURSDAY between the hours of 8:30 AM and 7 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for Regular/After Final Actions and 571-273-6714 for Non-Official/Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Shahid Kamal  
October 10, 2008

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685